

ESTTA Tracking number: **ESTTA1160318**Filing date: **09/17/2021**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following parties has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	Columbia Pictures Industries, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	10202 W. WASHINGTON BLVD. CULVER CITY, CA 90232 UNITED STATES		

Name	Sony Pictures Television Inc.		
Entity	Corporation	Citizenship	Delaware
Address	10202 W. WASHINGTON BLVD. CULVER CITY, CA 90232 UNITED STATES		

Attorney information	RICHARD S. MANDEL / JOELLE A. MILOV COWAN, LIEBOWITZ & LATMAN, P.C. 114 WEST 47TH STREET NEW YORK, NY 10036 UNITED STATES Primary Email: rsm@ccl.com Secondary Email(s): jam@ccl.com, trademark@ccl.com (212) 790-9200
Docket Number	

Registration Subject to Cancellation

Registration No.	5094663	Registration date	12/06/2016
Registrant	Cobra Kai Jiu Jitsu LLC 1525 W. OAKLEY LAS VEGAS, NV 89102 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 2003/05/01 First Use In Commerce: 2003/05/01
All goods and services in the class are subject to cancellation, namely: Providing general fitness and mixed martial arts facilities that require memberships and are focused in the fields of general fitness, exercise, and mixed martial arts

Grounds for Cancellation


Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
False suggestion of a connection with persons,	Trademark Act Sections 14(3) and 2(a)


living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute	
Other	Priority and likelihood of confusion based on common law


Marks Cited by Petitioner as Basis for Cancellation


U.S. Registration No.	6003343	Application Date	06/21/2018
Registration Date	03/03/2020	Foreign Priority Date	NONE
Word Mark	COBRA KAI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2018/05/02 First Use In Commerce: 2018/05/02 PRODUCTION AND DISTRIBUTION OF LIVE-ACTION TELEVISION PROGRAMS; PROVIDING NON-DOWNLOADABLE TELEVISION PROGRAMS AND TRAILERS BY MEANS OF AN INTERACTIVE GLOBAL COMPUTER NETWORK; PROVIDING NON-DOWNLOADABLE TELEVISION PROGRAMS VIA VIDEO-ON-DEMAND SERVICE; PROVIDING A WEBSITE FEATURING INFORMATION ABOUT TELEVISION PROGRAMS		

U.S. Registration No.	6003344	Application Date	06/21/2018
Registration Date	03/03/2020	Foreign Priority Date	NONE
Word Mark	COBRA KAI		

Design Mark	
Description of Mark	The mark consists of a stylized representation of a cobra with the words "COBRA KAI" in stylized letters.
Goods/Services	Class 041. First use: First Use: 2018/05/02 First Use In Commerce: 2018/05/02 PRODUCTION AND DISTRIBUTION OF LIVE-ACTION TELEVISION PROGRAMS; PROVIDING NON-DOWNLOADABLE TELEVISION PROGRAMS AND TRAILERS BY MEANS OF AN INTERACTIVE GLOBAL COMPUTER NETWORK; PROVIDING NON-DOWNLOADABLE TELEVISION PROGRAMS VIA VIDEO-ON-DEMAND SERVICE; PROVIDING A WEBSITE FEATURING INFORMATION ABOUT TELEVISION PROGRAMS

U.S. Registration No.	6283585	Application Date	06/21/2018
Registration Date	03/02/2021	Foreign Priority Date	NONE
Word Mark	COBRA KAI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2019/01/01 First Use In Commerce: 2019/01/01 Posters; stickers; pen and pencil cases, boxes and holders; graphic prints; comic books; paperback books in the field of fiction; calendars; children's story books; coloring books; notepads; writing pads; diaries; scrapbook albums; iron-on transfers		


U.S. Registration No.	6283586	Application Date	06/21/2018
Registration Date	03/02/2021	Foreign Priority Date	NONE
Word Mark	COBRA KAI		
Design Mark			
Description of Mark	The mark consists of a stylized representation of a cobra with the words "COBRA KAI" in stylized letters.		
Goods/Services	Class 016. First use: First Use: 2019/01/01 First Use In Commerce: 2019/01/01 Calendars, posters; stickers; pen and pencil cases, boxes and holders; graphic prints; notepads; writing pads; diaries		


U.S. Application No.	88009899	Application Date	06/21/2018
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	COBRA KAI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 DVDs featuring audiovisual content in the fields of motion pictures, televisionpro-		

	grams, and games; video game software; downloadable video game software; video discs featuring motion pictures, television programs, and games; computer game software for use with personal computers, video game consoles, handheld and mobile devices, arcade video game machines, and bingo devices; smart-phone software applications for playing computer games; eyeglasses; sunglasses; downloadable sound, image, and music files containing motion pictures; CDs and DVDs featuring movie soundtracks; downloadable e-books in the field of motion pictures; computer, phone, and pc tablet cases
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U.S. Application No.	88010073	Application Date	06/21/2018
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	COBRA KAI		
Design Mark			
Description of Mark	The mark consists of a stylized representation of a cobra with the words "COBRAKAI" in stylized letters.		
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 DVDs featuring audiovisual content in the fields of motion pictures, television programs, and games; video game software; downloadable video game software; video discs featuring motion pictures, television programs, and games; computer game software for use with personal computers, video game consoles, handheld and mobile devices, arcade video game machines, and bingo devices; smart-phone software applications for playing computer games; eyeglasses; sunglasses; downloadable sound, image, and music files containing motion pictures; CDs and DVDs featuring movie soundtracks; downloadable e-books in the field of motion pictures; computer, phone, and pc tablet cases		

U.S. Application No.	88010095	Application Date	06/21/2018
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	COBRA KAI		

Design Mark	
Description of Mark	The mark consists of a stylized representation of a cobra with the words "CO-BRAKAI" in stylized letters.
Goods/Services	Class 028. First use: First Use: 0 First Use In Commerce: 0 Toys, games and playthings, namely, toyfigurines; scale model kits; paintable toy figurines; stuffed toy figures; flying discs; inflatable toys; toy masks; amusement game machines; electric toy vehicles; toy and novelty face masks; toys, namely, children's dress-up accessories;play sets for action figures; skateboards; pinball and coin-operated amusement machines; playing cards; balloons; dolls; board games; slot machines; reconfigurable casino and lottery gaming machines,namely, gaming machines and operationalcomputer game software therefor sold asa unit; machines that accept wagering; lottery cards; lottery tickets; scratch cards for playing lottery games

U.S. Application No.	88009917	Application Date	06/21/2018
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	COBRA KAI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 CLOTHING, NAMELY, JEANS, UNDERWEAR; SLEEPWEAR; SOCKS;		

	SHOES; SLIPPERS; HEADWEAR; HATS; FOOTWEAR; APRONS; COVER-ALLS; SWEATSHIRTS; SWEATPANTS; ATHLETIC PANTS ANDSHIRTS; SHORTS; SWEATERS; JACKETS; INFANT CLOTHING, NAMELY, ONE-PIECE CLOTHING AND PAJAMAS; T-SHIRTS, COSTUMES FOR INFANTS, CHILDREN, AND ADULTS, NAMELY, HALLOWEEN COSTUMES AND COS-TUMES FOR USE IN CHILDREN'S DRESS UP PLAY
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U.S. Application No.	88010089	Application Date	06/21/2018
Registration Date	NONE	Foreign Priority Date	NONE


Word Mark	COBRA KAI
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Design Mark	
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Description of Mark	The mark consists of a stylized representation of a cobra with the words "CO-BRAKAI" in stylized letters.
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Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 CLOTHING, NAMELY, JEANS, UNDERWEAR; SLEEPWEAR; SOCKS; SHOES; SLIPPERS; HEADWEAR; HATS; FOOTWEAR; APRONS; COVER-ALLS; SWEATSHIRTS; SWEATPANTS; ATHLETIC PANTS ANDSHIRTS; SHORTS; SWEATERS; JACKETS; INFANT CLOTHING, NAMELY, ONE-PIECE CLOTHING AND PAJAMAS; T-SHIRTS, COSTUMES FOR INFANTS, CHILDREN, AND ADULTS, NAMELY, HALLOWEEN COSTUMES AND COS-TUMES FOR USE IN CHILDREN'S DRESS UP PLAY
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U.S. Application No.	88009937	Application Date	06/21/2018
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	COBRA KAI		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 028. First use: First Use: 0 First Use In Commerce: 0 Toys, games and playthings, namely, toyfigurines; scale model kits; paintable toy figurines; stuffed toy figures; flying discs; inflatable toys; toy masks; amusement game machines; electric toy vehicles; toy and novelty face masks; toys, namely, children's dress-up accessories;play sets for action figures; skateboards; pinball and coin-operated amusement machines; playing cards; balloons; dolls; board games; slot machines; reconfigurable casino and lottery gaming machines,namely, gaming machines and operationalcomputer game software therefor sold asa unit; machines that accept wagering; lottery cards; lottery tickets; scratch cards for playing lottery games

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	COBRA KAI, alone or with other word, letter, and/or design elements		
Goods/Services	entertainment services and related products and services		

Attachments	88009948#TMSN.png(bytes) 88010104#TMSN.png(bytes) 88009928#TMSN.png(bytes) 88010084#TMSN.png(bytes) 88009899#TMSN.png(bytes) 88010073#TMSN.png(bytes) 88010095#TMSN.png(bytes) 88009917#TMSN.png(bytes) 88010089#TMSN.png(bytes) 88009937#TMSN.png(bytes) COBRA KAI Cancellation Petition.pdf(73516 bytes)
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Signature	/Joelle A. Milov/
Name	Joelle A. Milov
Date	09/17/2021

In re Registration No. 5,094,663
Registered: December 6, 2016
For Mark: COBRA KAI JIU JITSU

Petitioners Columbia Pictures Industries, Inc. (“Columbia”) and Sony Pictures Television Inc. (“SPT”) (collectively, “Petitioners”) believe that they will be damaged by registration of the mark shown in Registration No. 5,094,663 (the “Registration”), registered December 6, 2016, and hereby petition to cancel the same.

1. Petitioner Columbia is a Delaware corporation with an address at 10202 W. Washington Blvd., Culver City, California 90232.

2. Petitioner SPT is a Delaware corporation with an address at 10202 W. Washington Blvd., Culver City, California 90232.

3. Upon information and belief, Respondent Cobra Kai Jiu Jitsu LLC (“Respondent”) is a Nevada limited liability company with an address at 1525 W. Oakley, Las Vegas, Nevada 89102.

4. Petitioners are related entities that are both subsidiaries of the world-renowned entertainment company Sony Pictures Entertainment, Inc. Columbia is in the business of producing, acquiring, and distributing audiovisual entertainment products, including motion pictures, and is also engaged in licensing intellectual property associated with such entertainment products for use on a wide variety of goods and services. SPT is in the business of producing, acquiring, and distributing television programs and digital content, and is also engaged in licensing intellectual property associated with its content for use on a wide variety of goods and services.

5. Among the many successful, high-profile entertainment properties produced by Petitioners is THE KARATE KID franchise, which includes multiple motion pictures and television series, as well as video games and other licensed merchandise.

6. The original motion picture THE KARATE KID was produced and distributed by Columbia and released in 1984. Starring Ralph Macchio, Pat Morita, Elisabeth Shue and William Zabka, THE KARATE KID grossed more than \$90 million domestically, making it the fourth-highest grossing film of 1984. The film tells the story of Daniel LaRusso, a teenager who learns karate from a karate master working as a handyman in the apartment complex where Daniel lives with his mother. Daniel uses his newly learned karate skills to defend himself and compete in tournaments against rivals from a dojo named COBRA KAI, which is prominently featured throughout the movie.

7. The success of THE KARATE KID motion picture spawned three sequels also produced and distributed by Columbia. THE KARATE KID PART II was released in 1986 and became the third-highest grossing film of the year, grossing more than \$115 million domestically. Columbia released additional sequels titled THE KARATE KID PART III in 1989

and THE NEXT KARATE KID in 1994. Columbia also produced a 2010 remake of THE KARATE KID featuring a similar storyline, but with different characters and focused on kung fu rather than karate.

8. THE KARATE KID, THE KARATE KID PART II and THE KARATE KID PART III films all prominently feature the fictional COBRA KAI dojo as a significant element. These films have all remained in continuous distribution following their initial release via broadcast television, cable television, video on demand and/or download/streaming services, as well as DVDs and/or Blu-ray discs. As a result, the public has been continuously exposed to the COBRA KAI designation as an important element of THE KARATE KID universe and entertainment properties for more than three decades.

9. In 2018, SPT introduced a martial arts television series titled COBRA KAI, which is based on THE KARATE KID films and is set more than three decades after the original movie. Ralph Maccio and William Zabka reprise their roles as middle-aged, former enemies Daniel LaRusso and Johnny Lawrence. The characters renew a rivalry of sorts after Johnny Lawrence opens a new, poorly-funded COBRA KAI karate dojo.

10. SPT launched the COBRA KAI television series in 2018 on the YouTube Red subscription service where it became extremely popular. It ran for two seasons in 2018 and 2019 before YouTube decided to stop producing original programming. Netflix then acquired the COBRA KAI series in 2020 and released the third season in January 2021. The series' popularity exploded during the pandemic, becoming the top-rated show in Nielsen's streaming ratings with Netflix users watching some 2.11 billion minutes' worth of the show's three seasons. The fourth season of COBRA KAI is scheduled for release in December 2021 and the series has already been renewed for a fifth season.

11. SPT has also licensed a video game, COBRA KAI: THE KARATE KID SAGA CONTINUES, based on the television series. The video game was released for PlayStation 4, Xbox One and Nintendo Switch in October 2020 and for Microsoft Windows in January 2021. SPT has also licensed a mobile game entitled COBRA KAI: CARD FIGHTER, which was released in March 2021 on iOS and Android devices.

12. SPT owns the following federal trademark registrations and applications for marks comprising or containing the term COBRA KAI:

<u>MARK</u>	<u>REG./APP. NO.</u>	<u>GOODS/SERVICES</u>
COBRA KAI	6,003,343	Production and distribution of live-action television programs; providing non-downloadable television programs and trailers by means of an interactive global computer network; providing non-downloadable television programs via video-on-demand service; providing a website featuring information about television programs (Class 41)
COBRA KAI & Design	6,003,344	Production and distribution of live-action television programs; providing non-downloadable television programs and trailers by means of an interactive global computer network; providing non-downloadable television programs via video-on-demand service; providing a website featuring information about television programs (Class 41)
COBRA KAI	6,283,585	Posters; stickers; pen and pencil cases, boxes and holders; graphic prints; comic books; paperback books in the field of fiction; calendars; children's story books; coloring books; notepads; writing pads; diaries; scrapbook albums; iron-on transfers (Class 16)
COBRA KAI & Design	6,283,586	Calendars; posters; stickers; pen and pencil cases, boxes and holders; graphic prints;

<u>MARK</u>	<u>REG./APP. NO.</u>	<u>GOODS/SERVICES</u>
		notepads; writing pads; diaries (Class 16)
COBRA KAI	88/009,899	DVDs featuring audiovisual content in the fields of motion pictures, television programs, and games; video game software; downloadable video game software; video discs featuring motion pictures, television programs, and games; computer game software for use with personal computers, video game consoles, handheld and mobile devices, arcade video game machines, and bingo devices; smartphone software applications for playing computer games; eyeglasses; sunglasses; downloadable sound, image, and music files containing motion pictures; CDs and DVDs featuring movie soundtracks; downloadable e-books in the field of motion pictures; computer, phone and pc tablet cases (Class 9)
COBRA KAI & Design	88/010,073	DVDs featuring audiovisual content in the fields of motion pictures, television programs, and games; video game software; downloadable video game software; video discs featuring motion pictures, television programs, and games; computer game software for use with personal computers, video game consoles, handheld and mobile devices, arcade video game machines, and bingo devices; smartphone software applications for playing computer games; eyeglasses; sunglasses; downloadable sound, image, and music files containing motion pictures; CDs and DVDs featuring movie soundtracks; downloadable e-books in the field of motion pictures; computer, phone and pc tablet cases (Class 9)
COBRA KAI	88,009,937	Toys, games and playthings, namely, toy figurines; scale model kits; paintable toy figurines; stuffed toy figures; flying discs; inflatable toys; toy masks; amusement game machines; electric toy vehicles; toy and

MARK**REG./APP. NO.****GOODS/SERVICES**

novelty face masks; toys, namely, children's dress-up accessories; play sets for action figures; skateboards; pinball and coin-operated amusement machines; playing cards; balloons; dolls; board games; slot machines; reconfigurable casino and lottery gaming machines, namely, gaming machines and operational computer game software therefor sold as a unit; machines that accept wagering; lottery cards; lottery tickets; scratch cards for playing lottery games (Class 28)

COBRA KAI
& Design

88/010,095

Toys, games and playthings, namely, toy figurines; scale model kits; paintable toy figurines; stuffed toy figures; flying discs; inflatable toys; toy masks; amusement game machines; electric toy vehicles; toy and novelty face masks; toys, namely, children's dress-up accessories; play sets for action figures; skateboards; pinball and coin-operated amusement machines; playing cards; balloons; dolls; board games; slot machines; reconfigurable casino and lottery gaming machines, namely, gaming machines and operational computer game software therefor sold as a unit; machines that accept wagering; lottery cards; lottery tickets; scratch cards for playing lottery games (Class 28)

COBRA KAI

88/009,917

Clothing, namely, jeans, underwear; sleepwear; socks; shoes; slippers; headwear; hats; footwear; aprons; coveralls; sweatshirts; sweatpants; athletic pants and shirts; shorts; sweaters; jackets; infant clothing, namely, one-piece clothing and pajamas; t-shirts; costumes for infants, children, and adults, namely, Halloween costumes and costumers for use in children's dress up play (Class 25)

COBRA KAI

88/010,089

Clothing, namely, jeans, underwear; sleepwear; socks; shoes; slippers; headwear;

MARK**REG./APP. NO.****GOODS/SERVICES**

hats; footwear; aprons; coveralls; sweatshirts; sweatpants; athletic pants and shirts; shorts; sweaters; jackets; infant clothing, namely, one-piece clothing and pajamas; t-shirts; costumes for infants, children, and adults, namely, Halloween costumes and costumers for use in children's dress up play (Class 25)

13. As a result of the great success of THE KARATE KID movies long featuring the COBRA KAI mark, and the COBRA KAI television series, Petitioners have developed highly valuable goodwill in the COBRA KAI mark, which is closely associated with Petitioners and THE KARATE KID entertainment franchise, including most recently the hit television show COBRA KAI, and the related products and services offered under the mark.

14. On or about April 6, 2016, decades after Columbia first used the COBRA KAI mark as a prominent element in THE KARATE KID motion pictures, Respondent filed Application Serial No. 86/966,713, in the United States Patent & Trademark Office ("USPTO") seeking to register the mark COBRA KAI JIU JITSU ("Respondent's Mark") for "providing general fitness and mixed martial arts facilities that require memberships and are focused in the fields of general fitness, exercise, and mixed martial arts" in International Class 41.

15. On December 6, 2016, the USPTO issued Respondent the Registration for Respondent's Mark for the Class 41 services cited above. Respondent claims a date of first use for Respondent's Mark of May 1, 2003, again well after Columbia had established substantial public recognition in the COBRA KAI mark as a result of the huge success of THE KARATE KID motion pictures prominently featuring such mark.

16. Upon information and belief, Respondent adopted and selected Respondent's Mark with the intention of trading upon the fame and success of the COBRA KAI mark

comprising part of THE KARATE KID entertainment franchise. Such bad faith intent is evidenced by, among other things, the fact that Respondent also adopted, used and later applied to register the same COBRA KAI logo design featured in THE KARATE KID movies as shown below:

THE COBRA KAI Logo Design
From THE KARATE KID



Respondent's Logo Design



17. The parties' marks are virtually identical, with Respondent's Mark simply adding the generic term "jiu jitsu," another form of martial arts closely associated with the subject matter of THE KARATE KID properties.

18. The services covered by the Registration are closely related to the goods and services for which Petitioners use their COBRA KAI mark because the subject matter of Petitioners' entertainment properties involves martial arts, and the COBRA KAI mark is used in Petitioners' works as the name of a fictional dojo providing instruction in martial arts.

19. Given the extensive public exposure and recognition of the COBRA KAI mark in Petitioners' entertainment properties in connection with martial arts, as well as the well-established practice of licensing intellectual property associated with entertainment properties for use on a wide variety of goods and services, consumers encountering Respondent's Mark used in connection with martial arts related services are likely to assume that Respondent's services are licensed by, or otherwise associated with, Petitioners. The fact that Respondent has also misappropriated the copyrighted COBRA KAI logo design featured in THE KARATE KID

movies and the COBRA KAI television series further heightens the inevitable confusion that results from Respondent's use of the term COBRA KAI.

20. Respondent's Mark so resembles Petitioner's COBRA KAI mark as to be likely, when used in connection with Respondent's services, to cause confusion, to cause mistake or to deceive the public into believing that Respondent's services have their origin with Petitioners and/or that Respondent's services are approved, endorsed, or sponsored by Petitioners or associated with Petitioners in some other way, thereby causing injury to Petitioners and the consuming public.

21. Petitioners will be further injured by the Registration because Respondent's Mark, which is a mostly identical approximation of Petitioners' COBRA KAI mark, and which points uniquely to Petitioners when used in connection with the applied-for services, would falsely suggest a connection between Petitioners and Respondent, which is not connected with or authorized by Petitioners.

22. Petitioners will be, and are being, injured by the Registration because Respondent's Mark so resembles Petitioners' COBRA KAI mark as to be likely, when used in connection with Respondent's services:

- (a) to cause confusion, or to cause mistake, or to deceive;
- (b) to falsely suggest a connection with Petitioners;
- (c) to damage Petitioners' valuable goodwill in their COBRA KAI mark; and
- (d) to interfere with Petitioners' sale and/or potential sale of their own goods and/or services under the COBRA KAI mark, including by

blocking SPT from obtaining a Class 25 registration for the
COBRA KAI mark to which it is lawfully entitled.

WHEREFORE, Petitioners, by their attorneys, respectfully request that their cancellation
petition be sustained and the Registration be cancelled.

Dated: New York, New York
September 17, 2021

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys for Petitioners

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